

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:) Docket No: ATC1P001
)
Thomas et al.)
) Group Art Unit: 2613
Application No: 09/098,279)
) Examiner: VO, Tung T.
Filed: June 16, 1998)
) Date: May 23, 2005
For: METHOD AND APPARATUS FOR)
REMOTE MONITORING AND CONTROL)
OVER A COMPUTER NETWORK)
_____)

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450 on May 23, 2005.

Signed: _____
Kay Harlow

TRANSMITTAL OF APPEAL BRIEF

Commissioner for Patents
Box: Board of Patent Appeals & Interferences
Alexandria, VA 22313-1450

RECEIVED

MAY 26 2005

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Sir:

This Appeal Brief is in furtherance of the Notice of Appeal filed in this case on December 23, 2004.

This application is on behalf of:

☒ Small Entity ☐ Large Entity

Pursuant to 37 CFR 1.17(f), the fee for filing the Appeal Brief is:

☒ \$250.00 (Small Entity) ☐ \$500.00 (Large Entity)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136 apply:

☒ Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

<u>Months</u>	<u>Large Entity</u>	<u>Small Entity</u>
<input type="checkbox"/> one	\$120.00	\$60.00
<input type="checkbox"/> two	\$450.00	\$225.00
<input checked="" type="checkbox"/> three	\$1,020.00	\$285.00 (2 month extension previously paid)
<input type="checkbox"/> four	\$1,590.00	\$795.00

If an additional extension of time is required, please consider this a petition therefor.

☒ An extension for 2 months has already been secured and the fee paid therefor of \$225.00 is deducted from the total fee due for the total months of extension now requested.

☒ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that Applicant has inadvertently overlooked the need for a petition and fee for extension of time.

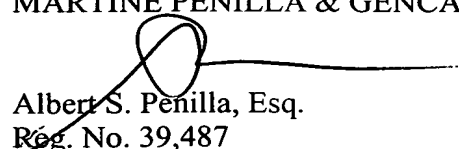
Total Fees Due:

Notice of Appeal Fee	<u>\$250.00</u>
Extension Fee (if any)	<u>\$285.00</u> (\$225.00 previously paid)
Total Fee Due	<u>\$535.00</u>

☐ Enclosed is Check No. _____ in the amount of \$_____.

☒ **PLEASE CHARGE FEES TO DEPOSIT ACCOUNT NO. 50-0850, (Order No. ATC1P001).** Two copies of this transmittal are enclosed.

Respectfully submitted,
MARTINE PENILLA & GENCARELLA, LLP


Albert S. Penilla, Esq.
Reg. No. 39,487

710 Lakeway Drive, Suite 200
Sunnyvale, CA 94085
(408) 774-6903
Customer No. 25920

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

EX PARTE THOMAS ET AL.

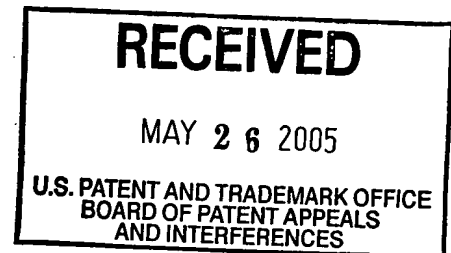
Application for Patent

Filed June 16, 1998

Serial No. 09/098,279

Group Art Unit 2613

Examiner: VO, Tung T.



FOR:

**METHOD AND SYSTEM FOR REMOTE MONITORING AND
CONTROL OVER A COMPUTER NETWORK**

APPEAL BRIEF

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on May 15, 2005.

Signed: _____

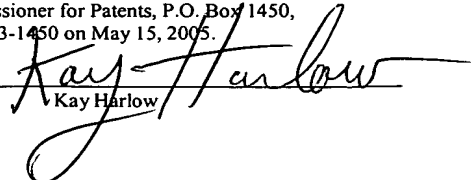

Kay Harlow

TABLE OF CONTENTS

INTRODUCTION.....	i
TABLE OF AUTHORITIES	iii
REAL PARTY IN INTEREST.....	1
RELATED APPEALS AND INTERFERENCES	1
STATUS OF THE CLAIMS.....	1
STATUS OF AMENDMENTS	2
CLAIMS ON APPEAL	2
SUMMARY OF THE INVENTION.....	2
GROUND OF REJECTION.....	3
GROUPING OF CLAIMS	3
ARGUMENT	3
 I. INTRODUCTION	 3
 II. RESTRICTION REQUIREMENT IS UNTIMELY AND SHOULD BE WITHDRAWN	 4
 III. REJECTION OF CLAIMS 1, 2, 4, 5, 7-9 AND 11-18 UNDER 35 USC §103(a) IS ERRONEOUS	 5
A. THERE IS NO MOTIVATION TO COMBINE NG AND GOLDBERG	5
B. CLAIMS 1 AND 8 ARE PATENTABLY DISTINCT FROM NG AND GOLDBERG	7
C. CLAIMS 13-15 ARE PATENTABLY DISTINCT FROM NG AND GOLDBERG	9
D. CLAIMS 17-18 ARE PATENTABLY DISTINCT FROM NG AND GOLDBERG	10
E. GOLDBERG IS NOT PRIOR ART	11
 CONCLUSION	 13
 APPENDIX A	 A-1

TABLE OF AUTHORITIES

CASES:

In re Deminski,

796 F.2d 436, 230 U.S.P.Q. 313 (Fed. Cir. 1986) 6

King Instrument Corp. v. Otari Corp.,

767 F.2d 853, 226 U.S.P.Q. 402 (Fed. Cir. 1985) 6

STATUTES:

American Inventors Protection Act (AIPA) of 1999,

Pub. L. No. 106-113, 113 Stat. 1501A-552, on November 29, 199913

REAL PARTY IN INTEREST

The real party in interest are the inventors.

RELATED APPEALS AND INTERFERENCES

It is believed that there are no other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF THE CLAIMS

This application was filed June 16, 1998 claiming domestic priority of U.S. Provisional Application No. 60/051,489, filed July 1, 1997. Claims 1, 4, 8, 26 and 31 were amended and claim 3 was cancelled in Amendment (A) filed on January 29, 2001. Claims 1, 8, 12, 13 and 26 were amended, and claims 6 and 10 were cancelled by Amendment (B) on October 1, 2001. Claims 19-25 were cancelled by Amendment (C) filed on February 22, 2002. Claims 32-44 were added by Supplemental Amendment (D) filed on February 25, 2002. In a Second Supplemental Amendment (E) filed on February 25, 2002, claims 1, 4, 7-9, 16-18, 33, 36, 39 and 44, and new claims 45-66 were added. Claims 1, 8, 39, 47, 49 and 52 were amended, and claims 32-38, 45-46 and 51 were cancelled. In a Final Office Action dated November 19, 2002 (Final Rejection), all claims (with the exception of claims 26-31) were finally rejected. Claims 1, 2, 4, 5, 7-9, 11-18, 26-31, 39-44, 47-50 and 52-66 were then appealed (Appeal I). In an Office Action dated July 30, 2003, the Examiner withdrew the Final Rejection and issued a Restriction Requirement. On September 8, 2003, a response to the Restriction Requirement was filed. In response to the Office Action of November 5, 2003, Amendment F was filed May 5, 2004 (resubmitted June 8, 2004). In a Final Office Action dated August 25, 2004 (Final Rejection), claims 1, 2, 4, 5, 7-9 and 11-18 were finally rejected, with the Examiner withdrawing and thus refusing

to further examine 26-31, 39-44, 47-50 and 52-66. Claims 1, 2, 4, 5, 7-9 and 11-18 were then appealed (Appeal II). No claim stands allowed at this time.

STATUS OF AMENDMENTS

All Amendments filed have been entered.

CLAIMS ON APPEAL

The claims on appeal are reproduced below in Appendix A, as required by 37 CFR § 1.192(c)(7).

SUMMARY OF THE INVENTION

The invention relates to improved techniques to remotely monitor locations and/or detect activity at the locations. Page 7. The monitoring and/or detecting is achieved over a network, such as global computer network. Pages 8-9. Claim 1 (method) and claim 8 (system) pertain to improved techniques can advantageously operate on general purpose computers and can efficiently make use of network bandwidth.

The remote monitoring of locations can be achieved by efficiently transmitting images over a network to a remote machine located at a remote location. Pages 7-10; Pages 11-15. In one embodiment, the efficiency is facilitated by comparing a current image with a reference image, and then only transmitting the current image if it differs from the reference image by more than a predetermined threshold amount. Figs. 7A-7B; Figs. 8 and 9A-9B; Pages 14-16. The remote monitoring can also operate as an alarm system or provide intruder detection based on detected changes in images from a locally provided camera. Figs. 7A-7B. In another embodiment, a motion detector can be used to detect motion and then trigger transmission of an image.

Further, in one embodiment, the transmitting of the images is done with electronic mail. Fig. 8. In another embodiment, the images can be stored to an

Internet server and thus are made remotely accessible over a network (e.g., global computer network) via a web browser application.

GROUND OF REJECTION

The issues presented on appeal are:

A. Whether the Restriction Requirement was unreasonable late and should be withdrawn.

B. Whether claims 1, 2, 4, 5, 7-9 and 11-18 are obvious over Ng (U.S. Patent 5,731,832) in view of Goldberg (U.S. Patent 6,526,158 B1).

GROUPING OF CLAIMS

For this appeal, claims 1, 2, 4, 5, 7-9 and 11-18 do not stand or fall together. Instead, these claims are argued individually in the following argument.

ARGUMENT

I. INTRODUCTION

The Examiner has finally rejected claims 1, 2, 4, 5, 7-9 and 11-18 under 35 USC § 103 as being allegedly unpatentable over a combination of two cited references. These various grounds are cumulative upon one another and thus should be considered in combination were appropriate.

First, Appellant will show that the late restriction requirement is improper and should be withdrawn.

Second, Appellant will show that there is no motivation to the combine the references as the Examiner has done.

Third, Appellant will show that the cited references do not teach or suggest configuring a general purpose computing device to automatically notify an interested user via a predetermined mailing address using an electronic mail message, and then subsequently electronically mailing an image from a camera to the interested user using the electronic mail message. Claims 1, 2, 4, 5, 7- 9 and 11-18 recite these limitations.

Fourth, Appellant will show that the cited references do not teach or suggest use of a physical motion detector to signal a notification unit of motion. Claims 13-15 recite these limitations.

Fifth, Appellant will show that the cited references do not teach or suggest transmitting alarm status information using an electronic mail message. Claims 17-18 recite these limitations.

Sixth, although fully distinguished on the merits, it is noted that Goldberg is believed to be effective as prior art under 35 USC §102(e) as of February 26, 1999, which is subsequent to the filing date of the present application.

II. RESTRICTION REQUIREMENT IS UNTIMELY AND SHOULD BE WITHDRAWN

The Restriction Requirement from paper 20 should be reconsidered and withdrawn. First, the late nature of this restriction after many years of examination is unreasonable. This is a clear case of piecemeal prosecution that the MPEP indicates is improper. All these claims were previously the subject of an appeal which was withdrawn by the USPTO and returned to the Examiner for further examination. On being returned to the Examiner, the late restriction requirement was issued. How can such a restriction requirement be timely if the restricted claims were previously finally rejected? While Applicants did elect without traverse, it was done with assurances from the Examiner that such would facilitate allowance of the elected claims. Allowance has not yet occurred, and Applicants now appeal must endure yet another appeal. Second, claims 26-31, 39-44, 47 and 48 are akin to the subject matter of claims 1, 2, 4, 5, 7-9 and 11-

18, thus the Examiner should be required to at least also continue to examine these claims. Third, examination of all claims in a single application would not be a substantial burden on the Examiner. According it is respectfully requested that the Board withdraw the restriction requirement as untimely and unreasonable.

**III. REJECTION OF CLAIMS 1, 2, 4, 5, 7-9 AND 11-18
UNDER 35 USC §103(a) IS ERRONEOUS**

In the Office Action, the Examiner rejected claims 1, 2, 4, 5, 7-9 and 11-18 under 35 USC §103(a) as being unpatentable over Ng (U.S. Patent 5,731,832) in view of Goldberg (U.S. Patent 6,526,158 B1). Appellant respectfully disagrees.

Ng describes a system for detecting motion in a video signal. The system detects motion in a video signal by identifying differences between a current image frame and a reference image frame. A motion detection signal is generated by the system if a difference profile between the current image frame and the reference image frame exceeds a threshold. Upon generation of a motion detection signal, the system may be configured to record the current image frame if the difference profile exceeds the threshold.

Goldberg describes a method and system for obtaining person-specific images in a public venue (e.g., theme park). The system employs a unique machine-readable identification tag (49) located in a device such as a card, pin or bracelet, which is attached to the patron (43). Electronic images of the patron are captured by digital cameras (63). "At a distribution station (77), the patron can view images (85) corresponding to his tag identification, and the images may be printed (87) or may be delivered in electronic form on a videotape, CD, or email."

**A. THERE IS NO MOTIVATION TO COMBINE NG AND
GOLDBERG**

The Examiner arrives at the conclusion that the claims are unpatentable through hindsight analysis. As the Federal Circuit has so many times reiterated:

"Hindsight analysis is clearly improper, since the statutory test is whether 'the subject matter as a whole would have been obvious at the time the invention was made.' " *In re Deminski*, 796 F.2d 436, 230 U.S.P.Q. 313 (Fed. Cir. 1986). That is, the selective combination of bits and pieces from each of the two references utilized by the Examiner to reject the claims is the result of hindsight gleaned from the invention itself. There is nothing in any of the cited references or any assertions as to the knowledge of those with ordinary skill in the art that would lead those skilled in the art to combine the references in the manner asserted by the Examiner.

To support such rejections based on a combination of references, the Examiner is required to provide evidence that suggests the desirability of the combination. *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853, 226 U.S.P.Q. 402 (Fed. Cir. 1985). In Final Office Action, the Examiner did not provide sufficient evidence of record that would suggest the desirability of these combinations. The Examiner has merely asserted that it would be *obvious* to those skilled in the art to combine specific features of each of the references to allegedly produce the claimed invention.

Furthermore, given the disparate teachings of Ng and Goldberg, one skilled in the art would not be motivated to combine these reference in the manner that the Examiner proposes. In Goldberg, image distribution stations 77 (e.g., kiosks) can be accessed by patrons to print the images or have them delivered in electronic form on a videotape, CD, or email. The Examiner proposes to combine the image distribution of Goldberg with the system of Ng for detecting motion in an image represented by a video signal. However, Ng already has image transmission to a remote location using a modem when motion is detected. Hence, Ng does not have need for the image distribution stations 77 of Goldberg. Moreover, in Ng the image transmission is intentionally automatic, whereas in Goldberg the image transmission is only on-demand by a patron after the patron arrives at the image distribution station 77. Consequently, one skill in the art would not find the combining of Goldberg with Ng to be helpful in overcoming the deficiencies of Ng. Indeed, the use of image distribution

stations 77 with Ng would conflict with the primary image transmission objectives of Ng. Accordingly, it is respectfully submitted that the combination of Ng with Goldberg is improper.

Based on the foregoing, it is submitted that the Examiner has failed to provide sufficient motivation within the cited references or the general knowledge of those with ordinary skill in the art which would lead one skilled in the art to combine the teachings of the references as the Examiner has done. Therefore, for this reason, it is further submitted that all claims are patentably distinct over Ng in view of Goldberg. Accordingly, it is respectfully requested that the Board reverse the Examiner's rejections and remand the application to the Examiner with directions to allow claims 1, 2, 4, 5, 7-9 and 11-18.

B. CLAIMS 1 AND 8 ARE PATENTABLY DISTINCT FROM NG AND GOLDBERG

Claim 1 pertains to a surveillance method for operating a general purpose computer to provide remote surveillance of an internal area of a building. Among other things, claim 1 recites "notifying an interested user of the activity condition when the presence of the activity condition is detected." Further, the notifying is further described in claim 1 as follows:

wherein said notifying includes at least transmitting the surveillance image to a remote computer over a global computer network automatically when the activity condition is detected, and

wherein said transmitting includes forming an electronic mail message having a predetermined mailing address, the predetermined mailing address being associated with the interested user and being provided during said configuring, and electronically mailing the surveillance image to the remote computer over the network using the electronic mail message.

Claim 1, lines 16-23.

In the Office Action, the Examiner admits that Ng is deficient in discussing transmitting the surveillance image over a network using an electronic mail message. However, the Examiner relies on Goldberg which indicates that

patrons can distribute images via electronic mail. Hence, the Examiner alleges that claim 1 is unpatentable over Ng in view of Goldberg. Applicants respectfully disagree.

According to Goldberg, images are captured for a patron at various locations in an entertainment venue. Goldberg teaches that patrons can, while at image distribution stations, send images to an electronic mail address. However, such image distribution is not automatically performed upon detecting an activity condition as recited in claim 1. Indeed, Goldberg teaches against sending images automatically on detection of an activity condition. That is, in Goldberg, the images are only later transmitted if, and when, a patron visits an image distribution station and the patron initiates an action at the image distribution station. Goldberg also does not detect activity conditions. Hence, the image distribution station of Goldberg does not and cannot operate to automatically transmit images using an electronic mail message and a predetermined mailing address on detection of an activity condition.

In addition, claim 1 recites “configuring, prior to said receiving, comparing, detecting and notifying, said general purpose computing device so as to automatically notify the interested user via a predetermined mailing address when an activity condition is subsequently detected” (claim 1, lines 12-15). Neither Ng nor Goldberg teach or suggest a configuring act. Ng does not teach or suggest any use of a predetermined mailing address, as noted by the Examiner. Goldberg only mentions electronic mail in the context of a possible option for a patron at an image distribution station, which occurs at user’s direction after image acquisition. In contrast, claim 1 requires advance configuration in order to subsequently provide automatic notifications to an interested user via a predetermined mailing address. As such, Goldberg fails to teach or suggest the advance configurations as recited in claim 1.

Still further, there is no disclosure, suggestion or motivation of record that would lead one of ordinary skill in the art to combine these references in the manner proposed by the Examiner. Ng concerns detecting motion in video.

signals, while Goldberg concerns personalized photographic images of patrons at an entertainment venue. The respective technologies and problems concerning these references are completely different. Accordingly, it is respectfully submitted that the combination of Ng and Goldberg is improper. Even if these references were somehow combinable, the combination would, at best, use electronic mail at an image distribution station (e.g., kiosk) to distribute already acquired images, but only after a patron visits the image distribution station.

Therefore, it is submitted that claim 1 is patentably distinct over Ng and Goldberg for at least the reasons noted above.

Claim 8 pertains to a system for providing remote visual monitoring of a location. Further, claim 8 recites limitations similar to those discussed above regarding claim 1. Hence, it is submitted that claim 8 is also patentably distinct from the combination of Ng and Goldberg for at least similar reasons as claim 1.

Based on the foregoing, it is submitted that claims 1 and 8 are patentably distinct over Ng in view of Goldberg. Accordingly, it is respectfully requested that the Board reverse the Examiner's rejections and remand the application to the Examiner with directions to allow claims 1, 2, 4, 5, 7-9 and 11-18.

C. CLAIMS 13-15 ARE PATENTABLY DISTINCT FROM NG AND GOLDBERG

In the final Office Action, the Examiner rejected claim 13 under 35 USC §103(a) as being unpatentable over Ng in view of Goldberg. However, in doing so, the Examiner makes no mention of the limitations of claim 13. Claim 13, which depends from independent claim 8, recites:

wherein said system further comprises a motion detector for producing a motion indication signal, and wherein said local general purpose computer receives the motion indication signal and determines whether an activity condition is present based on the motion indication signal.

Claim 13, lines 1-6.

The motion detector recited in claim 8 is an apparatus that is part of a system. Here, instead of image comparison techniques, a physical motion detector apparatus is provided and used to signal a notification unit. FIG. 6 of the present patent application illustrates a motion detector 617 being proximately located or integral to a camera 604. Furthermore, claims 14 and 15 clearly confirm that the motion detector is a physical apparatus.

Ng clearly detects motion by identify differences in image frames. Hence, Ng provides no need for use of a physical motion detector. Ng's innovation was to detect motion in a video signal; hence, there would be no motivation to utilize a physical motion detector as is recited in claim 13. Claim 14 recites "said motion detector is mounted on said camera." Ng equally fails to motivate one skilled in the art to mount a motion detector to a camera. Goldberg fails to teach or suggest a physical motion detector or mounting the motion detector on the camera.

Regardless, the Examiner's rejection of claim 13-15 is not adequate to make out a *prima facie* rejection. Unfortunately, the final Office Action makes no reference to the limitations recited in claims 13-15. Thus, it is submitted that the Examiner has failed to make out a *prima facie* rejection of claim 13-15.

Based on the foregoing, it is submitted that claims 13-15 are patentably distinct over Ng in view of Goldberg. Accordingly, it is respectfully requested that the Board reverse the Examiner's rejections and remand the application to the Examiner with directions to allow claims 13-15.

D. CLAIMS 17-18 ARE PATENTABLY DISTINCT FROM NG AND GOLDBERG

In the final Office Action, the Examiner rejected claim 17 under 35 USC §103(a) as being unpatentable over Ng in view of Goldberg. However, in doing so, the Examiner makes no mention of the limitations of claim 17. Claim 17, which depends from independent claim 8, recites:

wherein said security system detects an alarm condition, said local general purpose computer causes the image and alarm status information to be forwarded over the network to said remote computer.

Claim 17, lines 3-5.

Claim 18 depends from claim 17 and, therefore, includes the same limitations as claim 17. Here, alarm status information is automatically forwarded over the network with the image using an electronic mail message. Ng does teach transmission of an image to a remote location using a modem 28. However, there is no teaching or suggestion in either Ng or Goldberg for transmitting alarm status information.

Regardless, the Examiner's rejection of claim 17-18 is not adequate to make out a *prima facie* rejection. Unfortunately, the final Office Action makes no reference to the limitations recited in claims 17-18. Thus, it is submitted that the Examiner has failed to make out a *prima facie* rejection of claim 17-18.

Based on the foregoing, it is submitted that claims 17-18 are patentably distinct over Ng in view of Goldberg. Accordingly, it is respectfully requested that the Board reverse the Examiner's rejections and remand the application to the Examiner with directions to allow claims 17-18.

E. GOLDBERG IS NOT PRIOR ART

As noted above, the Examiner rejected all claims under 35 USC §103(a) in view of the combination of Ng and Goldberg. As explained below, Goldberg is not prior art against the present patent application; therefore, each and every rejection under 35 USC §103(a) is fatally defective.

The present patent application was filed June 16, 1998 and claimed domestic priority of U.S. Provisional Application No. 60/051,489, filed July 1, 1997. Hence, the effective filing date of the present patent application is July 1, 1997.

Goldberg, as cited by the Examiner, is U.S. Patent 6,526,158 B1. A U.S. patent can be effective as prior art under 35 USC §102(a) as of its issue date. The issue date of Goldberg is February 25, 2003. Since the filing date of the present patent application is well before February 25, 2003, Goldberg is unable to qualify as prior art under 35 USC §102(a).

A patent application filed in the United States can qualify as prior art as of its filing date 35 USC §102(e), provided that the patent application issues into a patent. The American Inventors Protection Act (AIPA) of 1999, Pub. L. No. 106-113, 113 Stat. 1501A-552, on November 29, 1999, made dramatic changes to 35 USC §102(e) of the Patent Act. The Effective date of the AIPA is November 29, 2000. Hence, the amendment to the Patent Laws apply to all patents and all patent application for patents pending on or filed after November 29, 2000.¹

Goldberg, however, resulted from a PCT International Application that was filed on September 3, 1997. Consequently, the pre-AIPA 35 USC §102(e) applies and such a PCT International Application can only be deemed a patent application filed United States after the requirements of 35 USC §371(c)(1), (2) and (4) have been satisfied. Goldberg, on its face, indicates that the

¹ See “35 U.S.C. §§ 102(e) and 374 as amended by H.R. 2215 (Technical Amendment Act),” Office of Patent Legal Administration (OPLA), USPTO, November 14, 2002. The effective date provision of section 4508 of the AIPA as revised by HR 2215 states:

Patents resulting from an international application filed before November 29, 2000 and applications published pursuant to section 122(b) or Article 21(2) of the treaty defined in section 351(a) resulting from an international application filed before November 29, 2000 shall not be effective as prior art as of the filing date of the international application; however, such patents shall be effective as prior art in accordance with section 102(e) in effect on November 28, 2000.

Id., slide 11.

requirements of 35 USC §371(c)(1), (2) and (4) were satisfied on February 26, 1999 (§371(c)(1), (2) and (4) date). Goldberg thus fails to qualify as prior art 35 USC §102(e) against the present patent application. Also, while Goldberg does claim priority to two earlier provisional applications, the Examiner makes no assertions that these provisional filings support an earlier prior art date for Goldberg 35 USC §102(e). Regardless of adequate support in such provisional filings, a PCT International Application, or a U.S. patent resulting therefrom, is not entitled to an earlier prior art effect by way of an earlier filed provisional application.²

The publication date for the PCT International Application was March 12, 1998. However, the Examiner neither cited nor rejected any claims based on the corresponding PCT publication WO 98/10358. Even if the Examiner were to attempt to reject the claims using the PCT publication WO 98/10358, the effective filing date of the present patent application is July 1, 1997 due to the priority benefit provided by U.S. Provisional Application No. 60/051,489.

Accordingly, it is respectfully requested that the Board reverse the Examiner's rejections and remand the application to the Examiner with directions to allow all claims.

CONCLUSION

Claim 39-44, 47-50 and 52-66 were improperly restricted from examination. The Board should require the Examiner to continue to examine

² Id. (The comments provided in slide 11 further state: "This provides that: 1) patent and application publication references may not rely on an IA filing date for § 102(e) purposes if that date is before 11/29/00, nor may such international application be used as a bridge to an earlier U.S. filing date for prior art purposes, and 2) 35 USC § 371 date is used for patents of IAs filed prior to 11/29/00.").

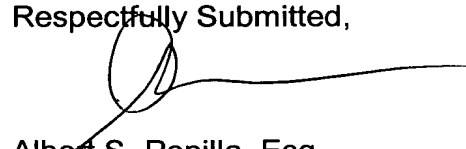
these restricted, and now withdrawn claims, so as to prevent further piecemeal examination. Appellants have shown that the Examiner's rejection of claims 1, 2, 4, 5, 7-9 and 11-18 under 35 USC § 103 over the combination of Ng and Goldberg is erroneous. For at least the reasons set forth in this Appeal Brief, the Board should reverse the Final Rejection and should order the Examiner to pass this application to allowance.

Applicants hereby petition for a third-month extension of time. The Notice of Appeal was received by the USPTO on December 27, 2004, setting a due date of February 27, 2005 to file the Appeal Brief. A two-month extension has already been acquired and paid for; therefore, the additional cost for the third month extension is authorized below (\$285.00). Accordingly, the extended due date is May 27, 2005.

The small entity fee for filing this Appeal Brief is \$250.00, and the extension of time fee is \$285.00. The fee total due is \$535.00, and such amount should be charged to Deposit Account No. 50-0805 (Order No. ATC1P001).

If any additional fees are required in connection with the filing of this Appeal Brief, the Commissioner is authorized to charge Deposit Account No. 50-0805 (Order No. ATC1P001).

Respectfully Submitted,



Albert S. Penilla, Esq.
Reg. No. 39,487

(408) 749-6903